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APPEAL BRIEF

This Appeal Brief is provided in support of the Notice of Appeal filed December

27, 2007 following the Final Office Action mailed September 27, 2007.

I.   Real Party in Interest

The real party in interest is VistaPrint Technologies Limited, a wholly owned subsidiary of VistaPrint Limited.

II.   Related Appeals and Interferences

There are no related appeals or interferences.

III.   Status of Claims

Pending claims 1-3, 5, 6, 8-21, 23, 24 and 26-36 have been twice rejected and are the subject of this appeal. Claims 4, 7, 22, 25 have been canceled. No other claims are pending.

IV.   Status of Amendment

No amendments have been filed subsequent to the final rejection.

V. Summary of the Claimed Subject Matter

The pending claims relate to systems and methods for automatically preparing and presenting a second customized product to a user while the user is in the process of ordering a first product.

Independent Claim 1

Claim 1 recites a computer-implemented method for use in creating an electronic design of a two-sided product intended for subsequent printing. The method comprises

providing an image (FIG. 3, element 302) of at least a portion of a first side of the product for displaying to the user of a client computer (FIG. 1, element 100) for customization by the user (page 7, lines 9-13, paragraph 0028),

providing a tool (FIG. 1, element 106; FIG. 3, element 304) allowing the user to supply at least text to be printed on the first side (page 7, line 14 – page 8, line 2, paragraphs 0029, 0030),

providing an image (FIG. 5, elements 504, 406, 508; FIG. 8, element 804) of at least a portion of a second side of the product for displaying to the user for customization by the user (page 8, lines 19-20, paragraph 0033), the second side of the product having a map area (FIG. 5, bolded portion of elements 504, 506, 508) where a map will be printed when the product is printed (page 9, lines 2-8 and 10-16),

providing a tool (FIG. 7, element 700) allowing the user to identify a location (FIG. 7, elements 702, 704, 706) to be included within the map that will be printed in the map area (page 9, line 22 – page 10, line 3, paragraph 0037),

making electronic map information (FIG. 1, elements 114, 150) available to a server computer system (FIG. 1, element 110), the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (page 10, lines 12-22, paragraph 0039),

in response to information received from the client computer system (FIG. 1, element 100) (page 9, lines 12-16) identifying a location (FIG. 7, elements 702, 704, 706) within the relatively large geographical area, obtaining a relatively high resolution user map (FIG. 1, element 115) from the map information, the user map covering a relatively small geographical area that includes at least the identified location (page 10, line 12 through page 11, line 6, paragraphs 0039, 0040, 0041),

generating a lower resolution display map version (FIG. 1, element 116) of the user map (FIG. 1, element 115), the display map being suitable for displaying at the client (page 11, lines 6-8, paragraph 0041),

transmitting the display map (FIG. 1, element 116) to the client for displaying to the user (page 11, lines 6-8, paragraph 0041),

receiving a description (FIG. 1, element 112) of the product design from the client, the description identifying at least a portion of the display map (page 8, lines 19-22, paragraph 0033, page 9, lines 11-13, paragraph 0035, page 11, lines 5-6, paragraph 0041), and

associating the identified portion of the display map (FIG. 1, element 116) with the corresponding higher resolution map information (FIG. 1, element 115) such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information (page 11, lines 5-6, paragraph 0041, page 12, lines 25-27, paragraph 0045).

Dependent Claim 3

Claim 3 recites providing a user-controllable crop box (FIG. 8, element 804) allowing the user to identify a desired portion of the display map (FIG. 8, element 802) (page 11, lines 12-13 and line 22 through page 12, line 10, paragraphs 0042 and 0043).

Dependent Claim 5

Claim 5 recites generating a thumbnail version (FIG. 1, element 117) of the display map and storing the thumbnail version (FIG. 1, element 117) at the server (page 11, lines 9-11, paragraph 0041).

Dependent Claim 6

Claim 6 recites retrieving the stored thumbnail version in response to a request from the user and transmitting the thumbnail version (FIG. 1, element 117) to the client computer system (FIG. 1, element 100) for viewing by the user (page 11, lines 9-11, paragraph 0041).

Dependent Claim 8

Claim 8 recites wherein the user map (FIG. 8, element 802) is based on address information supplied by the user for printing on the first side of the product (FIG. 3, element 304) (page 9, lines 25-27).

Dependent Claim 9

Claim 9 recites wherein the information received includes a zoom level (FIG. 7, element 708) to be used to obtain the user map (page 10, lines 4-11, paragraph 0038).

Dependent Claim 10

Claim 10 recites wherein the user map (FIG. 8, element 802) is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area (page 10, lines 12-22, paragraph 0039).

Dependent Claim 11

Claim 11 recites wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the map area (page 10, lines 12-22, paragraph 0039).

Independent Claim 12

Independent Claim 12 recites a computer-implemented method for use in creating an electronic design of a product intended for subsequent printing on two sides, the method comprising

displaying an image (FIG. 5, elements 504, 406, 508; FIG. 8, element 804) of at least a portion of one side of the product to the user of a client computer (FIG. 1, element 100), the side of the product having a map area (FIG. 5, bolded portion of elements 504, 506, 508) where a map will be printed when the product is printed (page 9, lines 2-8 and 10-16),

displaying a tool (FIG. 7, element 700) allowing the user to identify a location (FIG. 7, elements 702, 704, 706) to be included within the map that will be printed in the map area (page 9, line 22 – page 10, line 3, paragraph 0037),

supplying information (page 9, lines 12-16) to a server computer system (FIG. 1, element 110) having access to map information (FIG. 1, elements 114, 150) covering a relatively large geographical area and adapted to produce relatively high resolution maps, the supplied information identifying at least a location within the relatively large geographical area (page 10, line 12 through page 11, line 6, paragraphs 0039, 0040, 0041),

receiving a display map (FIG. 1, element 116) from the server, the display map (FIG. 1, element 116) covering a relatively small geographical area that includes at least the identified location (FIG. 7, elements 702, 704, 706) and being at a relatively low resolution suitable for displaying at the user computer (page 11, lines 6-8, paragraph 0041),

displaying at least a portion of the display map such that the displayed portion of the display map is displayed to the user in the map area (page 11, lines 6-8, paragraph 0041), and

transmitting a description (FIG. 1, element 112) of the electronic product design to the server for subsequent printing of the product (page 8, lines 19-22, paragraph 0033, page 9, lines 11-13, paragraph 0035, page 11, lines 5-6, paragraph 0041), the description identifying the incorporated portion of the display map such that the server can associate the received product design with a corresponding higher resolution map at the server (page 11, lines 5-6, paragraph 0041, page 12, lines 25-27, paragraph 0045).

Dependent Claim 15

Claim 15 recites allowing the user to supply different information to the server (FIG. 1, element 110) such that a different display map will be received wherein the different information is a different zoom level (page 10, lines 8-11, paragraph 0038).

Dependent Claim 16

Claim 16 recites displaying the display map with a user-controllable crop box (FIG. 8, element 804) such that the user can vary the portion of the display map displayed in the map area (FIG. 8, element 802) (page 11, lines 12-13 and line 22 through page 12, line 10, paragraphs 0042 and 0043).

Dependent Claim 17

Claim 17 recites requesting a display of one or more thumbnail map images (FIG. 1, element 117) stored on the server (FIG. 1, element 110),

selecting one of the displayed thumbnail images (FIG. 9, elements 902, 904, 906), and

receiving a display map associated with the selected thumbnail images from the server (page 13, lines 14-19, paragraph 0047).

Dependent Claim 18

Claim 18 recites replacing the at least a portion of the received display map currently displayed in the map area with at least a portion of the received display map associated with a selected thumbnail image (page 13, lines 14-19, paragraph 0047).

Independent Claim 19

Independent Claim 19 recites a computerized system for use in creating an electronic design of a two-sided product intended for subsequent printing, the system comprising

means for providing an image (FIG. 3, element 302) of at least a portion of a first side of the product for displaying to the user of a client computer (FIG. 1, element 100) for customization by the user (page 7, lines 9-13, paragraph 0028),

means for providing a tool (FIG. 1, element 106; FIG. 3, element 304) allowing the user to supply at least text to be printed on the first side (page 7, line 14 – page 8, line 2, paragraphs 0029, 0030),

means for providing an image (FIG. 5, elements 504, 406, 508; FIG. 8, element 804) of at least a portion of a second side of the product for displaying to the user for customization by the user (page 8, lines 19-20, paragraph 0033), the second side of the product having a map area (FIG. 5, bolded portion of elements 504, 506, 508) where a map will be printed when the product is printed (page 9, lines 2-8 and 10-16),

means for providing a tool (FIG. 7, element 700) allowing the user to identify a location (FIG. 7, elements 702, 704, 706) to be included within the map that will be printed in the map area (page 9, line 22 – page 10, line 3, paragraph 0037),

means for making electronic map information (FIG. 1, elements 114, 150) available to a server computer system (FIG. 1, element 110), the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (page 10, lines 12-22, paragraph 0039),

means, responsive to information received from the client computer system (FIG. 1, element 100) (page 9, lines 12-16) identifying a location (FIG. 7, elements 702, 704, 706) within the relatively large geographical area, for obtaining a relatively high resolution user map (FIG. 1, element 115) from the map information, the user map covering a relatively small geographical area that includes at least the identified location (page 10, line 12 through page 11, line 6, paragraphs 0039, 0040, 0041),

means for generating a lower resolution display map version (FIG. 1, element 116) of the user map (FIG. 1, element 115), the display map being suitable for displaying at the client (page 11, lines 6-8, paragraph 0041),

means for transmitting the display map (FIG. 1, element 116) to the client for displaying to the user (page 11, lines 6-8, paragraph 0041),

means for receiving a description (FIG. 1, element 112) of the product design from the client, the description identifying at least a portion of the display map (page 8, lines 19-22, paragraph 0033, page 9, lines 11-13, paragraph 0035, page 11, lines 5-6, paragraph 0041), and

means for associating the identified portion of the display map (FIG. 1, element 116) with the corresponding higher resolution map information (FIG. 1, element 115) such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information (page 11, lines 5-6, paragraph 0041, page 12, lines 25-27, paragraph 0045).

Dependent Claim 21

Claim 21 recites means for providing a user-controllable crop box (FIG. 8, element 804) allowing the user to identify a desired portion of the display map (FIG. 8, element 802) (page 11, lines 12-13 and line 22 through page 12, line 10, paragraphs 0042 and 0043).

Dependent Claim 23

Claim 23 recites means for generating a thumbnail version (FIG. 1, element 117) of the display map and storing the thumbnail version (FIG. 1, element 117) at the server (page 11, lines 9-11, paragraph 0041).

Dependent Claim 24

Claim 24 recites means for retrieving the stored thumbnail version (FIG. 1, element 117) in response to a request from the user and means for transmitting the thumbnail version to the client computer system for viewing by the user (page 11, lines 9-11, paragraph 0041).

Dependent Claim 27

Claim 27 recites wherein the information received includes a zoom level (FIG. 7, element 708) to be used to obtain the user map (page 10, lines 4-11, paragraph 0038).

Dependent Claim 28

Claim 28 recites wherein the user map (FIG. 8, element 802) is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area (page 10, lines 12-22, paragraph 0039).

Dependent Claim 29

Claim 29 recites wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the map area (page 10, lines 12-22, paragraph 0039).

Independent Claim 30

Independent Claim 30 recites a computer-implemented system for use in creating an electronic design of a product intended for subsequent printing, the system comprising

means for displaying an image (FIG. 5, elements 504, 406, 508; FIG. 8, element 804) of at least a portion of one side of the product to the user of a client computer (FIG. 1, element 100), the side of the product having a map area (FIG. 5, bolded portion of elements 504, 506, 508) where a map will be printed when the product is printed (page 9, lines 2-8 and 10-16),

means for displaying a tool (FIG. 7, element 700) allowing the user to identify a location (FIG. 7, elements 702, 704, 706) to be included within the map that will be printed in the map area (page 9, line 22 – page 10, line 3, paragraph 0037),

means for supplying information (page 9, lines 12-16) to a server computer system (FIG. 1, element 110) having access to map information (FIG. 1, elements 114, 150) covering a relatively large geographical area and adapted to produce relatively high resolution maps, the supplied information identifying at least a

location within the relatively large geographical area (page 10, line 12 through page 11, line 6, paragraphs 0039, 0040, 0041),

means for receiving a display map (FIG. 1, element 116) from the server, the display map (FIG. 1, element 116) covering a relatively small geographical area that includes at least the identified location (FIG. 7, elements 702, 704, 706) and being at a relatively low resolution suitable for displaying at the user computer (page 11, lines 6-8, paragraph 0041),

means for displaying at least a portion of the display map such that the displayed portion of the display map is displayed to the user in the map area (page 11, lines 6-8, paragraph 0041), and

means for transmitting a description (FIG. 1, element 112) of the electronic product design to the server for subsequent printing of the product (page 8, lines 19-22, paragraph 0033, page 9, lines 11-13, paragraph 0035, page 11, lines 5-6, paragraph 0041), the description identifying the incorporated portion of the display map such that the server can associate the received product design with a corresponding higher resolution map at the server (page 11, lines 5-6, paragraph 0041, page 12, lines 25-27, paragraph 0045).

Dependent Claim 33

Claim 33 recites wherein the different information is a different zoom level (FIG. 7, element 708) (page 10, lines 8-11, paragraph 0038).

Dependent Claim 34

Claim 34 recites means for displaying the display map with a user-controllable crop box (FIG. 8, element 804) such that the user can vary the portion of the display map displayed in the map area (FIG. 8, element 802) (page 11, lines 12-13 and line 22 through page 12, line 10, paragraphs 0042 and 0043).

Dependent Claim 35

Claim 35 recites means for requesting a display of one or more thumbnail map images (FIG. 1, element 117) stored on the server (FIG. 1, element 110),

means for selecting one of the displayed thumbnail images (FIG. 9, elements 902, 904, 906), and

means for receiving a display map associated with the selected thumbnail images from the server (page 13, lines 14-19, paragraph 0047).

Dependent Claim 36

Claim 36 recites means for replacing the at least a portion of the received display map currently displayed in the map area with at least a portion of the received display map associated with a selected thumbnail image (page 13, lines 14-19, paragraph 0047).

VI.   Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-3, 5, 6, 8-21, 23, 24 and 26-36 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Von Kaenel (U.S. Patent 7,107,286) in view of Applicants' comments regarding the prior art in the Background of the Invention section of the pending application (referred to by the Examiner as "Applicant's Own Admission", or "AOA").

VII.   Argument

Claims 1, 3-4, 6-8, 10, 16-18, and 20-21 are NOT unpatentable under 35
U.S.C. 103(a) as being unpatentable over Von Kaenel (U.S. Patent 7,107,286)
in view of Applicants' comments regarding the prior art in the Background of
the Invention section of the pending application (referred to by the Examiner
as "Applicant's Own Admission", or "AOA").

A. Discussion of Applicant's Claimed Invention

In the pending application, uses and benefits of the claimed invention are
illustrated in the context of a flexible electronic product customization system,
shown generally in Applicant's FIG. 1, which allows a template provider to give
users the ability to customize and incorporate a map of a user-specified location
into the electronic design of a product.   As discussed in the Applicant's
Specification at least at paragraph [0020] (page 4, lines 14-30), a product design
tool 106 runs in a browser 105 of a user computer 100 and allows the user to
prepare a customized product design in electronic form. When the customer is
satisfied with the design of the product, the design can be uploaded to a server 110
for storage and, if desired by the user, a desired quantity of the physical product
may be produced on appropriate printing and post-print processing systems.

Referring to the Applicant's FIG. 3, and as discussed in the Specification at
least at paragraph [0033] (page 7, lines 9-13), the design tool 106 provides the user
with a template 302 of a product, for example a front side of a business card as
illustrated. The user can customize the content of the template, for example by
entering custom text in the text boxes 304 (paragraph [0029]), modifying or
repositioning the text boxes (paragraph [0030]), changing the font, and performing
other customization actions (paragraph [0030]).

Referring to the Applicant's FIG. 4, and as discussed in the Specification at
least at paragraphs [0033]-[0034] (page 8, line 19- page 9, line 9), the user is
presented with business card backside template 402 which in the illustrated

example has been pre-filled by the template designer with a placeholder text line suggesting that the user may wish to place the user's company message on the backside of the card. The user has the option of choosing another backside by clicking on text button 404. Applicant's FIG. 5 illustrates, among other categories, a number of different map style templates 504, 506, 508. As described in paragraph [0035] (page 9, lines 10-16), the portion of the backside template that will be occupied by a map is indicated in FIG. 5 by bold outlining. For example, in template 504, the entire backside of the card will be covered by a map. In template 506, the right side of the backside would be a map while the remainder would be available for text or other content. Template 508 shows another variation with the map occupying most of the backside and a relatively small area available for text.

As shown in Applicant's FIG. 6 and described in paragraph [0036] (page 9, lines 17-21) of the Applicant's Specification, when the user clicks on the thumbnail of the desired backside map template, the user is presented with map function window 600. Window 600 presents the user with three text button options: create new map 602, change cropping of current map 604, and choose saved map 606. If the user selects create new map 602, the user is presented with address and zoom window 700, shown in Applicant's FIG. 7. As described in paragraphs [0037] and [0038] (page 9, line 22 – page 10, line 11), the address and zoom window include editable address lines and zoom level boxes 702, 704, 706, and 708. The user may edit the address lines which shall be included in a map that shall be incorporated into the map area of the selected backside template. The user may also select a zoom level for the map.

As described in paragraph [0039] (page 10, lines 12-22) of the Applicant's Specification, when the user clicks next 712, design tool 106 sends the address line contents and zoom level information to server 110 together with map container information. The map container information could be, for example, the height and width of the map container in the template or a container identifier established by the service provider that enables the server to determine the height to width ratio of the map image container. At server 110, the server structures a map request to

local mapping software 114 (see Applicant's FIG. 1) using the address and the zoom level. The map request is also structured such that the resulting map returned by local map 114 will have sufficient information to provide a printable image of high quality, typically 300 dots per inch or greater, when the map image is placed in the template map container and will have a height to width ratio that is substantially the same as the height to width ratio of the map container in the template.

As described in the Applicant's Specification at paragraph [0041] (page 11, lines 3-11) and as shown in FIG. 1 in the image memory 113, the returned map is stored by server 110 in print image memory 115 as a high resolution map version to be used as the source of the product map during subsequent printing of the product. A lower resolution version of the map suitable for displaying to the user, typically at 72 dpi, is generated by server 110 from the returned user map and transmitted to UCS 100. The lower resolution version is stored in image memory 113 in display image memory 116 for possible future use. A smaller thumbnail version of the map is also created and stored in thumbnail image memory 117.

Referring to Applicant's FIG. 8 and paragraph [0042]-[0043] on page 11, line 12 – page 12, line 10 of Applicant's Specification, display version of the returned map is displayed to the user as map image 802. Crop box 804 is displayed over image 802. The portion of image 802 inside of crop box 804 will be the portion of the map image that will be incorporated into template 402. The user can reposition the crop box by positioning the user's mouse over the crop box and executing a drag-and-drop operation. The user can also, if desired, resize crop box 804 by using the mouse to grab one of the four resizing handles 806, 808, 810 and 812 located at the corners of the box and dragging the handle in a substantially diagonal motion to either enlarge or reduce the box size. The height to width ratio of crop box 804 is locked by the system to be the same as the map area of the selected backside template. The user can resize the box using the corner handles, but, regardless of the manner in which the user attempts to move the user's mouse, any resizing will be constrained by the system to maintain a constant height to width ratio.

Upon selection of the next button 816 in Applicant's FIG. 8, the user is returned to the backside editing screen depicted in Applicant's FIG. 4, and the portion of the map image 802 contained in the crop box 804 at the time the button 816 was selected is displayed in the map area of the template 402. (Page 12, lines 23-27, paragraph 0045 of Applicant's Specification).

The claimed invention thus allows a user to easily customize a map to a specific user-provided location and to easily incorporate it into the electronic design of a product.

The claimed systems and methods are directed at computer-implemented electronic document design systems and methods allowing a user to integrate user-specific location maps into custom printed products.

B. Response to Rejection of Claims Under 35 U.S.C. §103

Turning now to the specific rejection of the claims, namely 35 U.S.C. §103(a), in *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. *See* 383 U. S., at 15–17. The analysis is objective:

> "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, longfelt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.*, at 17–18.

The Courts have taught us that "[t]o reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness . . . . On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the

prima facie case with evidence of secondary indicia of nonobviousness." *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329, 1334-37 (Fed. Cir. 2006) (quoting *In Re Rouffett*, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998).) The burden to rebut a rejection of obviousness, however, does not arise until a prima facie case has been established. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

As expounded in *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972), "[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification." The CCPA has subsequently added that the prima facie case requires that the reference teachings "appear to have suggested the *claimed subject matter.*" *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 147 (CCPA 1976) (emphasis added). Thus, the Examiner must explain why the prior art would appear to show the *claimed* subject matter and not simply the general aspects of the invention.

In the discussion below, the Applicant shall show that the Examiner has not established a prima facie case of obviousness.

The Examiner has not established a prima facie case of obviousness

In order to establish a prima facie case of obviousness, the Examiner must provide one or more references that were available to the inventor that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

1. Inventor's Own Work May not be considered prior art by admission

In *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984), the Federal Circuit court considered an obviousness challenge to a patent in which certain claims referred to

the patentee's own patent in both the specification section entitled "Summary of the Prior Art" and in the preamble to a Jepson claim. The *Reading & Bates* court held ... that the patentee's discussion of his own patent in the specification section entitled "Summary of the Prior Art" did not constitute an admission that the patent was prior art. In reaching its conclusion, the court reviewed our precedent and recognized the "policy behind requiring a statutory basis before one's own work may be considered as prior art." *Id.* at 650, 223 USPQ at 1171 (citing *In re Fout*, 675 F.2d 297, 213 USPQ 532).

"[T]here is an important distinction between the situation where the inventor improves upon his own invention and the situation where he improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work." *Id.*, 223 USPQ at 1172.

"[J]ust as a patent issued to the same inventive entity cannot be prior art by admission, an application issued to the same inventive entity cannot be prior art under section 102(e)." *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003) (*See In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 391 (Fed. Cir. 1983) ("An applicant may also overcome a reference by showing that the relevant disclosure is a description of the applicant's own work. The pertinent inquiry is under 35 U.S.C. 102(e).") (footnote omitted); *In re Land*, 368 F.2d 866, 878, 151 USPQ 621, 632 (CCPA 1966)).

The Examiner contends that portions of the Applicant's Specification constitute an Admission of prior art. In particular, the Examiner refers to paragraphs [0002] and [0003] as disclosing "the advantages of using an external print service". (See Office Action, page 3, paragraph 8). In particular, the Examiner points to the underlined sentences in the following paragraphs reprinted below from the Applicant's Specification:

> [0002] Many individuals, businesses, and organizations occasionally <u>have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional</u>

postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials.
and

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user. Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design. When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

However, to the extent that these paragraphs actually teach anything, the computerized systems for creating customized product designs, as referred to in paragraph [0003], is the Applicant's own work. In paragraph [0021] of the Applicant's Specification, reprinted below for the convenience of the reader, the Applicant refers to the computerized product design program as being provided by VistaPrint, Limited, the assignee of record in the present application.

[0021] When UCS 100 is operating, an instance of the USC 100 operating system will be running, represented in Fig. 1 by operating system 103. In addition, the user may be running one or more application programs. In Fig. 1, UCS 100 is running Web browser 105, such as Internet Explorer from Microsoft Corporation. Other applications that may be running in USC 100, such as spreadsheet, e-mail, and presentation programs, are represented as applications 104. In the depicted embodiment, design tool 106 is a product design program downloaded to UCS 100 via network 120 from remote server 110, such as downloadable design tools provided by VistaPrint Limited and publicly available at vistaprint.com....

Indeed, each of the following U.S. Patents describe the computerized systems for creating customized product designs referred to in the present application, and are assigned to the same assignee of record as the present application:

U.S. Patent 7,339,598 entitled "System and Method for Automated Product Design", filed Jul. 11, 2003, and issued Mar. 4, 2008;

U.S. Patent 7,322,007 entitled "Electronic Document Modification", filed May 30, 2003, and issued Jan. 22, 2008;

U.S. Patent 7,340,673 entitled "System And Method For Browser Document Editing", filed Aug. 29, 2002, and issued Mar. 4, 2008;

U.S. Patent 6,993,209 entitled "Low Resolution-To-High Resolution Image Correlation", filed Jul. 26, 2002 and issued Jan. 31, 2006;

U.S. Patent 7,020,838 entitled "System and Method for Identifying Line Breaks", filed Sep. 5, 2002 and issued Mar. 28, 2006

U.S. Patent 6,986,105 entitled "Methods Employing Multiple Clipboards for Storing and Pasting Textbook Components", filed Jun. 30, 2003 and issued Jan. 10, 2006;

U.S. Patent 7,133,050 entitled "Automated Image Resizing and Cropping", filed Aug. 22, 2003, and issued Nov. 7, 2006.

Accordingly, since the alleged AOA is in fact a description of the applicant's own work, per In Re Land, supra, the relevant disclosure is not an admission of prior art, and thus it cannot be used in establishing a prima facie case of obviousness in the present application.

2. Prior Art Does Not Teach Claimed Invention

Even if the discussion at paragraphs [0002] and [0003] in the Applicant's Specification were to be considered prior art, the combined teachings of Von Kaenel and the alleged "AOA" does not teach the claimed invention.

Claims 1-5 and 18-19

Independent Claim 1

Independent **Claim 1** is directed to:

A computer-implemented method for use in creating an electronic design of a two-sided product intended for subsequent printing, the method comprising

providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area,

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps,

in response to information received from the client computer system identifying a location within the relatively large geographical area, obtaining a relatively high resolution user map from the map information, the user map covering a relatively small geographical area that includes at least the identified location,

generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client,

transmitting the display map to the client for displaying to the user,

receiving a description of the product design from the client, the description identifying at least a portion of the display map, and

associating the identified portion of the display map with the corresponding higher resolution map information such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information.

Turning now to the *Von Kaenel* reference, Von Kaenal discloses a method, system, and program for providing access to spatial data. Per Von Kaenel's Abstract: A request for data is received. Enterprise and third party data are integrated. The integrated data is processed. Spatially referenced results are generated using the processed data. The spatially referenced results are returned in response to the request. (Von Kaenel, Abstract, and col. 8, lines 62-67).

More specifically, Von Kaenel discloses a method and system which can simultaneously access enterprise data and third party data, and then dynamically generate spatially referenced data (e.g., graphical representation of data on a map) based on a user's request. (Von Kaenel, col. 17, lines 6-12). In particular, as described in Von Kaenel at col. 16, line 60 – col. 17, line 5, Von Kaenel's system

provides data processing systems coupled with one or more realtime data centers to securely share, access, and/or distribute data from enterprise data stores at an enterprise combined with hosted data (e.g., enterprise or third party data) from the enterprise spatial system. The combined data is used to generate data layers to allow users to view, analyze, and share spatially referenced data using different client software (e.g., client applications). That is, *different client applications may retrieve the same data from the server system and provide different presentations of the data to the user, based on the needs of the user*. (Von Kaenel, col. 17, lines 2-5).

Von Kaenel does not teach or suggest the limitations "obtaining a relatively high resolution user map from the map information" and then "generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client." First, Von Kaenel does not teach or suggest "**obtaining** a ... **user map**". As generally depicted in Fig. 13 and described at col. 27, line 27 to col. 28, line 2 of Von Kaenel, a user submits a request to a server to view selected information. An example of the user's request is a request for a view of customer information and locations in a specific sales territory. Upon receipt by the server 1320 of a user request for information such as customer information and locations in a specific sales territory, data sets for each of customer information 1332, roads information 1331, and sales territory boundaries 1333 are retrieved from data store 1330 and each is transformed into a spatially referenced image (e.g., bitmap, JPEG, TIFF, etc.). (Von Kaenel, col. 27, lines 40-51). Each transformed data set 1331, 1332, 1333 corresponds to a *different* image layer 1351, 1352, 1353. (Von Kaenel, col. 27, lines 57-60). The *individual* image layers 1351, 1352, 1353 are sent to the client software 1310, which uses image **overlaying techniques to simultaneously display the requested image layers** 1351, 1352, 1353 to the user. (Von Kaenel, co. 27, lines 60-65). Thus, what Von Kaenel teaches is obtaining multiple image **layers**, and **not** "obtaining a ... user **map**" as required by Applicant's claim 1. In Von Kaenel, the "map" is created by the client at the time of display by overlaying each of the individual layers. The client does not "obtain"

the "map", but rather receives multiple image layers from the server and then simultaneously displays them to display a composite "map" image to the user.

Von Kaenel's FIG. 21 illustrates user selection of a single data layer, in particular, the "roads" data layer, which results in a request for the "roads" data layer being sent to the server system 2120. The server determines which data tables to use for the request using metadata logic and metadata, accesses the data tables, generates image layers for the requested "roads" data layer, and returns the image layers to the client for display. (Von Kaenel, col. 41, line 57 – col. 42, line 3). As illustrated in FIG. 21, the "roads" data layer includes data from the Interstates Table, the Streets Table, and the Alleys Table, resulting in an Interstates image layer, a Streets image layer, and an Alleys image layer – that is, multiple image layers (which correspond to the single "roads" data layer). Again, however, the client software 2110 must combine the multiple image layers to generate the composite "map" image displayed to the user.

Thus, because Von Kaenel discloses only combining multiple image layers to display a composite "map" image, Von Kaenel does not teach or suggest "obtaining a relatively high resolution user map from the map information."

Second, Von Kaenel does not teach or suggest anything about the relative resolutions of displayed and printed composite images. As explained above, Von Kaenel retrieves multiple image layers corresponding to one or more data layers. The individual image layers are sent directly to the client for display to the user. The Office Action cites Von Kaenel, col. 65, lines 19-67 as teaching "generating a *lower* resolution display map version of the user map." The Applicant respectfully disagrees. Col. 65, lines 19-67 of Von Kaenel discusses only the differences between the number of pixels available in enterprise spatial system workspace of the user interface (UI) screens (when displayed in the 800x600 resolution mode) when a vertical scroll bar is either displayed or not displayed on the UI screen. However, this teaches nothing about the relative resolutions of the image layers obtained by the server and those displayed to the user by the client. In fact, according to Von Kaenel, the image layers retrieved by the server in response to a user request are one and the same with the image layers sent to, and displayed to

the user by, the client. Thus, there is in fact *no disclosed difference in image resolution whatsoever between the image layers retrieved at the server and those sent to, and displayed at, the client.*

In addition, Von Kaenel also discloses no difference between the image layers retrieved by the server and those combined into a printable file. As depicted in Fig. 25 and described at col. 44, line 48 to col. 45, line 6, the von Kaenal reference describes allowing the user to print a copy of a displayed image by combining all of the image layers at the server into a printable file and sending the printable file to the user's computer for local printing by the user. Von Kaenel's FIG. 25, discussed in Von Kaenel at col. 44, lines 48-64, illustrates a method for allowing multiple data layers to be printed. As illustrated and discussed therein, upon receipt of a user request to print a composite image that is formed by overlaying multiple data layers (2510), the server gathers all of the requested data layers (2514), combines them into one printable file (2514), then sends them to the client software (2516) to print. The client software then prints the printable file (2518). Importantly, it appears that the image layers combined into the printable file are one and the same with the image layers sent to the client for combination and display. Accordingly, again, there is nothing in Von Kaenel that teaches or suggests any difference in resolution between the alleged "obtained" map and the map displayed on the client computer. Thus, Von Kaenel does not meet the limitations "obtaining a relatively **high resolution** user map from the map information" and "generating a **lower resolution** display map version of the user map, the display map being suitable for displaying at the client."

Von Kaenel also does not teach or suggest "transmitting the display **map** to the client for displaying to the user." As described above, what is transmitted to the user's computer is not the composite "map" image that is displayed to the user, but rather only the **individual** image layers 1351, 1352, 1353, which are retrieved from a data store 1330 by the server system 1320. (Von Kaenel, col. 27, line 27 to col. 28, line 2). Since client software 1310 running on the client computer must act to **overlay** the multiple image layers 1351, 1352, 1353 received from the server system 1320 in order to display the composite "map" image on the user's computer

screen, it cannot be said that a display map is *transmitted* to the client for displaying to the user.

Even if, for purposes of argument only and not admission, the transmission of the individual image layers by the server to the client were to be considered the transmission of a map to the client for displaying to the user, they still would not be considered the equivalent of the "display map" because the display map, as claimed by the Applicant, is a "**lower resolution** display map version of the user map." As discussed previously, the layers transmitted to the client from the server are not lower resolution layers from those retrieved from the data store. Accordingly, Von Kaenel does not meet the limitation "transmitting the display **map** to the client for displaying to the user", as recited in Applicant's claim 1.

Von Kaenel also does not teach or suggest "**receiving a description of the product design from the client, the description identifying at least a portion of the display map.**" In contradistinction to Applicant's claimed limitation, the client 1310 in Von Kaenel's system does not supply any description of a product design. Rather, as illustrated in FIG. 13, the client merely generates a request of the server for information such as customer information and locations in a specific sales territory, data sets for each of customer information 1332, roads information 1331, and sales territory boundaries 1333. The server retrieves the appropriate data set(s) corresponding to the request from data store 1330 and each is transformed into a spatially referenced image (e.g., bitmap, JPEG, TIFF, etc.). (Von Kaenel, col. 27, lines 40-51). However, the actual **request** from the client, which is the only element received by the server, is not a "description of the product design" as required by Applicant's Claim 1 because it does not describe an actual "design" of a product. Rather, the **request** describes only relevant data of which the client seeks.

The Office Action refers to Von Kaenel's FIGS. 30-31 and 33 as teaching the claimed limitation "receiving a description of the product design from the client, the description identifying at least a portion of the display map." However, as described in Von Kaenel at col. 55, lines 12-37, FIGS. 30A-30C merely illustrate allowing a user at a client computer to edit a layer of a composite image

3015 which is composed of many image layers 3005. When a particular image 3020 in a particular layer 3045 (i.e., the "edit layer") of the multiple layers 3005 is selected for editing, a background 3030 for editing is generated by combining all of the remaining images. The edit layer 3045 is requested from the server in an editable layer format 3050 by the client software. The term "editable layer format" refers to providing a wire frame outline of each editable data element. The edit layer 3055 and background 3030 are combined to form a combined background with an editable layer format 3040 that is displayed to a user, while editing. The user can make changes to the editable layer 3040 resulting in a combined background with edit layer changed. Von Kaenel's FIGS. 31A-31B merely illustrate how a user can edit existing items in spatially referenced data layers, and Von Kaenel's FIG. 33 shows how data layers that have been *retrieved by a user* to the user's client computer can be modified and assigned access privileges, and then sent back to the server for storage in the data store.

In contrast to Applicant's recited "product design", however, the combined background with editable layer 3040 is not "a description of the product design." Rather, it is a user-requested image of spatially referenced data with an editable image layer. The user-requested image of spatially referenced data is not incorporated into any "product design" but rather is displayed on its own. There is no indication whatsoever that the user-requested image of spatially referenced data is incorporated into and displayed in any product design image.

Thus, for all of the above reasons, Von Kaenel does not teach or suggest the limitation "receiving a description of the product design from the client, the description identifying at least a portion of the display map."

Von Kaenel also does not teach or suggest "**associating the identified portion of the display map with the corresponding higher resolution map information such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information.**" As explained previously, Von Kaenel does not disclose anywhere that the printed file will be of a higher resolution than the displayed image.

In addition to each of the above limitations, Von Kaenel also does not teach or suggest "providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user", "providing a tool allowing the user to supply at least text to be printed on the first side", "providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed," or "providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area." The Examiner cites AOA, and in particular, paragraphs [0002] and [0003] as teaching these limitations. However, even if the computerized systems for customizing product designs referred to in the paragraphs in question (as reprinted previously herein) were not barred as an admission of prior art under 35 U.S.C. §103(c) and *Riverwood Int'l Corp. v. R.A. Jones & Co., supra*, as described above, the paragraphs in question still do not teach the recited limitations missing from the Von Kaenel reference. Certainly there is no explicit teaching of the limitation "providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed." In fact, the alleged AOA is completely silent on the issue of providing images of a "second side of the product", and for providing a "map **area** where a map will be printed when the product is printed."

The courts have held that "[w]hen an examiner maintains that there is an explicit or implicit teaching or suggestion in the prior art, the examiner should indicate where (page and line or figure) such a teaching or suggestion appears in the prior art." *In re Jones*, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001) (unpublished) (citing *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), and *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (C.C.P.A. 1981)). The Examiner has failed to do this.

In the Office Action, the Examiner makes only the general statement that:

"Von Kaenel et al. does not appear to disclose printing on two sides, as recited, for example, in amended claim 1: providing an image of at least a portion of a first side of the product for displaying to the user of a client

computer for customization by the user, providing a tool allowing the user to supply at least text to be printed on the first side, providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed, or providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area." (*See* Office Action, page 5, paragraph 10.)

The Examiner then states that

"Applicants have admitted that it was known to edit various types of common print materials offline and that the editing tools were available (*See* Office Action, page 5, paragraph 11),

and from this concludes that

"[a] skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material." (*See* Office Action, page 5, paragraph 12).

The Examiner's focus on only the "two-sided" feature in the claims does not reasonably reveal to the Applicant where in the alleged AOA there exist teaching for the claim limitations including "providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user, providing a tool allowing the user to supply at least text to be printed on the first side, providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed, or providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area." Thus, contrary to the requirements set forth in *In re Jones, supra,* the Examiner has provided no specific page and line numbers or figure indicating where a teaching or suggestion of each and every one of the above limitations appear in the prior art. This leaves the Applicant in the unreasonable position of having to guess as to where the Examiner interprets the teachings of the claims to be present in the prior art.

In summary, the Applicant respectfully contends that Examiner has not shown that all elements in the recited claims are, in fact, prior art. In fact, the Examiner completely ignores many of the essential limitations of the claims, including "providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user," "providing a tool allowing the user to supply at least text to be printed on the first side," "providing an **image of at least a portion of a second side of the product** for displaying to the user for customization by the user, **the second side of the product having a map area where a map will be printed when the product is printed**," and "providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area." In addition, as described above, Von Kaenel also does not teach or suggest "obtaining a relatively **high resolution** user map from the map information," "generating a **lower resolution** display map version of the user map, the display map being suitable for displaying at the client," "transmitting the display **map** to the client for displaying to the user," "receiving a description of the product design from the client, the description identifying at least a portion of the display map," or "**associating the identified portion of the display map with the corresponding higher resolution map information such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information**." The Applicant respectfully submits that the 35 U.S.C. §103 rejection of Claim 1 should be withdrawn.

Dependent Claims 2, 3, 5, 6, and 8-11

Each of Claims 2, 3, 5, 6, and 8-11 depend from independent base Claim 1 and add further limitations and are thus believed allowable for at least the same reasons that independent Claim 1 is believed allowable over the cited references.

Claim 3 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 3, including "providing a user-controllable crop box allowing the user to identify a desired portion of the display map." Furthermore, the Office Action does not even

mention the limitations of claim 3 and is completely silent on where this limitation is taught in either Von Kaenel or AOA.

Claim 5 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 5, including "generating a thumbnail version of the display map and storing the thumbnail version at the server." As explained previously with respect to Claim 1, the image layers sent to the client from the server in Von Kaenel are the only images displayed to the user. Thus, they are not "thumbnails", but are in fact the full image to be displayed to the user. Furthermore, thumbnail images are reduced low resolution images of a full image. As also explained previously in the arguments set forth with respect to Claim 1, Von Kaenel does not teach or suggest that the image layers sent to the client and displayed at the client are any lower in resolution than those originally created.

Claim 6 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 6, including "retrieving the stored thumbnail version in response to a request from the user and transmitting the thumbnail version to the client computer system for viewing by the user." Per the arguments presented with respect to Claim 5, neither Von Kaenel nor AOA teach or suggest displaying "thumbnail" images.

Claim 8 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 8, including "wherein the user map is based on address information supplied by the user for printing on the first side of the product." Von Kaenel requires the user to specifically enter the desired regions of the image layers to display. Von Kaenel's system does not generate or retrieve map layers based on any address information input for any other purpose.

Claim 9 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 9, including "wherein the information received includes a zoom level to be used to obtain the user map." Both Von Kaenel and AOA are silent on any issue related to "zoom levels".

Claim 10 recites wherein the user map is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area. As described previously with respect to Claim 1, neither Von Kaenel nor AOA teach any element that can be equated with a "map area", and thus the claimed feature of obtaining a height and width ratio corresponding to the height and width ratio of the map area is also not taught by the cited references.

Claim 11 recites wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the map area. Again, neither Von Kaenel nor AOA teach a "map area".

Claims 12-18

Independent Claim 12

Independent Claim 12 recites a computer-implemented method for use in creating an electronic design of a product intended for subsequent printing on two sides, and includes similar limitations as those missing from Von Kaenel and AOA with respect to Applicant's Claim 1. In particular, Claim 12 recites "displaying an image of at least a portion of one side of the product to the user of a client computer, the side of the product having a **map area** where a map will be printed when the product is printed", "displaying a tool allowing the user to identify a location to be included within the map that will be printed in the **map area**", "receiving a display map from the server, the display map covering a relatively small geographical area that includes at least the identified location and being at a relatively low resolution suitable for displaying at the user computer", "displaying at least a portion of the display map such that the displayed portion of the display map is **displayed to the user in the map area**", and "**transmitting a description of the electronic product design to the server for subsequent printing of the product**, the description **identifying the incorporated portion of the display map** such that the server can associate the received product design with a **corresponding higher resolution map at the server**." As explained above with respect to Claim 1, neither Von Kaenel nor AOA teach the emphasized (in bold)

limitations of Claim 12. The Applicant respectfully submits that the 35 U.S.C. §103 rejection of Claim 12 should be withdrawn.

Dependent Claims 13-18

Each of Claims 13-18 depend from independent base Claim 12 and add further limitations and are thus believed allowable for at least the same reasons that independent Claim 12 is believed allowable over the cited references.

Claim 15 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 15, including "allowing the user to supply different information to the server such that a different display map will be received wherein the different information is a different zoom level." As explained previously with respect to Claim 9, both Von Kaenel and AOA are silent on any issue related to "zoom levels".

Claim 16 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 16, including "displaying the display map with a user-controllable crop box such that the user can vary the portion of the display map displayed in the map area." As explained previously with respect to Claim 3, both Von Kaenel and AOA are silent on any "user-controllable crop box".

Claim 17 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 17, including "requesting a display of one or more thumbnail map images stored on the server, selecting one of the displayed thumbnail images, and receiving a display map associated with the selected thumbnail images from the server." As explained previously with respect to Claim 5, both Von Kaenel and AOA are silent on any "thumbnail images".

Claim 18 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 18, including "replacing the at least a portion of the received display map currently displayed in the map area with at least a portion of the received display map associated with a selected thumbnail image." As explained previously with respect

to Claims 1 and 5, both Von Kaenel and AOA are silent on any "map area" or "thumbnail image".

Claims 19-24 and 26-29

<u>Independent Claim 19</u>

Independent Claim 19 recites a computerized system for use in creating an electronic design of a two-sided product intended for subsequent printing, and includes the same limitations as those missing from Von Kaenel and AOA with respect to Applicant's Claim 1, in apparatus form. Claim 19 is therefore believed allowable along the same rationale that Claim 1 is believed allowable. The Applicant respectfully submits that the 35 U.S.C. §103 rejection of Claim 19 should be withdrawn.

<u>Dependent Claims 20-24 and 26-29</u>

Each of Claims 20-24 and 26-29 depend from independent base Claim 19 and add further limitations and are thus believed allowable for at least the same reasons that independent Claim 19 is believed allowable over the cited references.

Claim 21 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "means for providing a user-controllable crop box allowing the user to identify a desired portion of the display map." As explained previously with respect to Claim 3, both Von Kaenel and AOA are silent on any "user-controllable crop box".

Claim 23 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "means for generating a thumbnail version of the display map and means for storing the thumbnail version at the server." As explained previously with respect to Claim 5, both Von Kaenel and AOA are silent on any "thumbnail images".

Claim 24 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "means for retrieving the stored thumbnail version in response to a

request from the user and means for transmitting the thumbnail version to the client computer system for viewing by the user." As explained previously with respect to Claim 5, both Von Kaenel and AOA are silent on any "thumbnail images".

Claim 27 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "wherein the information received includes a zoom level to be used to obtain the user map." As explained previously with respect to Claim 9, both Von Kaenel and AOA are silent on any issue related to "zoom levels".

Claim 28 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "wherein the user map is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area." As described previously with respect to Claim 1, neither Von Kaenel nor AOA teach any element that can be equated with a "map area", and thus the claimed feature of obtaining a height and width ratio corresponding to the height and width ratio of the map area is also not taught by the cited references.

Claim 29 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the map area." As described previously with respect to Claim 1, neither Von Kaenel nor AOA teach any element that can be equated with a "map area", and thus the claimed feature of obtaining a height and width ratio corresponding to the height and width ratio of the map area is also not taught by the cited references.

Claims 30-36

Independent Claim 30

Independent Claim 30 recites a computerized system for use in creating an electronic design of a two-sided product intended for subsequent printing, and includes the same limitations as those missing from Von Kaenel and AOA with respect to Applicant's Claim 12, in means-plus-function form. Claim 30 is

therefore believed allowable along the same rationale that Claim 12 is believed allowable. The Applicant respectfully submits that the 35 U.S.C. §103 rejection of Claim 30 should be withdrawn.

Dependent Claims 31-36

Each of Claims 31-36 depend from independent base Claim 30 and add further limitations and are thus believed allowable for at least the same reasons that independent Claim 30 is believed allowable over the cited references.

Claim 33 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "wherein the different information is a different zoom level." As explained previously with respect to Claim 9, both Von Kaenel and AOA are silent on any issue related to "zoom levels".

Claim 34 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "means for displaying the display map with a user-controllable crop box such that the user can vary the portion of the display map displayed in the map area." As explained previously with respect to Claim 3, both Von Kaenel and AOA are silent on any "user-controllable crop box".

Claim 35 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "means for requesting a display of one or more thumbnail map images stored on the server, means for selecting one of the displayed thumbnail images, and means for receiving a display map associated with the selected thumbnail images from the server." As explained previously with respect to Claim 5, both Von Kaenel and AOA are silent on any "thumbnail images".

Claim 36 is believed allowable on independent grounds because neither Von Kaenel nor AOA teach or suggest the limitations recited in Claim 21, including "means for replacing the at least a portion of the received display map currently displayed in the map area with at least a portion of the received display map associated with a selected thumbnail image." As explained previously with respect to Claim 1, both Von Kaenel and AOA are silent on any "map area".

3. AOA Is Not Enabling

Even if the discussion at paragraphs [0002] and [0003] in the Applicant's Specification were considered by the Board to be prior art, the combined alleged "AOA" is not enabling as to the limitations of the claimed invention missing from the Von Kaenel reference. It is well settled that although published subject matter is "prior art" for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must *enable* a person of ordinary skill to make and use the invention. *In re Kumar*, 418 F.3d 1361, 76 USPQ2d 1048, 1052-53 (Fed. Cir. 2005) (citing *Beckman Instruments, Inc. vl LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301 (Fed. Cir. 1989) (emphasis added). Thus when a prima facie case of obviousness is deemed made based on similarity to a known composition or device, rebuttal may take the form of evidence that the prior art does not enable the claimed subject matter. *Id. See In re Payne*, 606 F.2d 303, 314-315 (CCPA 1979) ("the presumption of obviousness based on close structural similarity is overcome where the prior art does not disclose or render obvious a method for making the claimed compound"); *In re Hoeksema*, 399 F.2d 269, 274 (CCPA 1968) ("the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds").

The alleged AOA includes paragraphs [0002] and [0003] of the Applicant's Specification. There is nothing in either of these two paragraphs that would enable one of ordinary skill in the art at the time of the invention to perform the steps of "providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, *the second side of the product having a map area where a map will be printed when the product is printed*, or providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area." The alleged AOA statement in paragraph [0003] which states "[c]omputerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized

product design" does not reasonably enable one of skill in the art how to provide an image of a second side of a product, wherein the image contains a map area. It also does not reasonably enable one of skill in the art on how to allow a user to identify a location for inclusion into the map area when the product is printed or how to actually include the map into the map area. Accordingly, since the alleged AOA does not enable these limitations missing from the Von Kaenel reference, the claimed invention cannot be rendered obvious based, at least in part, on the alleged AOA.
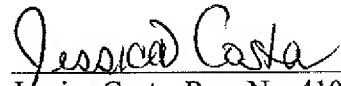
4. Summary

In summary, the Applicant respectfully contends that the Office has not established a prima facie case of obviousness under 35 U.S.C. §103. In particular, the alleged AOA cannot be considered an admission of prior art and therefore cannot be used in formulating a rejection under 35 U.S.C. §103. In addition, even if it were to be considered prior art for the purposes of the present application, it is not enabling with respect to the limitations against which it is cited. Finally, even in combination, the Von Kaenel and AOA do not teach all of the limitations recited in Applicant's Claim 1.

Conclusion

For the reasons set forth above, Applicant respectfully submits that each claim is patentable and reversal of all rejections is respectfully requested.

Respectfully submitted,

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VIII.   Claims Appendix

1. A computer-implemented method for use in creating an electronic design of a two-sided product intended for subsequent printing, the method comprising

providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area,

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps,

in response to information received from the client computer system identifying a location within the relatively large geographical area, obtaining a relatively high resolution user map from the map information, the user map covering a relatively small geographical area that includes at least the identified location,

generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client,

transmitting the display map to the client for displaying to the user,

receiving a description of the product design from the client, the description

identifying at least a portion of the display map, and

associating the identified portion of the display map with the corresponding

higher resolution map information such that when the product is printed the map

area on the second side of the product design will be printed using the higher

resolution map information.

2. The method of claim 1 further comprising storing the obtained user map at the

server.

3. The method of claim 1 further comprising providing a user-controllable crop

box allowing the user to identify a desired portion of the display map..

5. The method of claim 1 further comprising generating a thumbnail version of the

display map and storing the thumbnail version at the server.

6. The method of claim 5 further comprising retrieving the stored thumbnail

version in response to a request from the user and transmitting the thumbnail

version to the client computer system for viewing by the user.

8. The method of claim 1 wherein the user map is based on address information

supplied by the user for printing on the first side of the product .

9. The method of claim 1 wherein the information received includes a zoom level to be used to obtain the user map.

10. The method of claim 1 wherein the user map is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area.

11. The method of claim 1 wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the map area.

12. A computer-implemented method for use in creating an electronic design of a product intended for subsequent printing on two sides, the method comprising

displaying an image of at least a portion of one side of the product to the user of a client computer, the side of the product having a map area where a map will be printed when the product is printed,

displaying a tool allowing the user to identify a location to be included within the map that will be printed in the map area,

supplying information to a server computer system having access to map information covering a relatively large geographical area and adapted to produce relatively high resolution maps, the supplied information identifying at least a location within the relatively large geographical area,

receiving a display map from the server, the display map covering a

relatively small geographical area that includes at least the identified location and

being at a relatively low resolution suitable for displaying at the user computer,

displaying at least a portion of the display map such that the displayed

portion of the display map is displayed to the user in the map area, and

transmitting a description of the electronic product design to the server for

subsequent printing of the product, the description identifying the incorporated

portion of the display map such that the server can associate the received product

design with a corresponding higher resolution map at the server.

13. The method of claim 12 further comprising allowing the user to supply

different information to the server such that a different display map will be

received.

14. The method of claim 13 wherein the different information is a different

location.

15. The method of claim 13 wherein the different information is a different zoom

level.

16. The method of claim 12 further comprising displaying the display map with a

user-controllable crop box such that the user can vary the portion of the display

map displayed in the map area.

17. The method of claim 12 further comprising

requesting a display of one or more thumbnail map images stored on the

server,

selecting one of the displayed thumbnail images, and

receiving a display map associated with the selected thumbnail images

from the server.

18. The method of claim 17 further comprising replacing the at least a portion of

the received display map currently displayed in the map area with at least a portion

of the received display map associated with a selected thumbnail image.

19. A computerized system for use in creating an electronic design of a two-sided

product intended for subsequent printing, the system comprising

means for providing an image of at least a portion of a first side of the

product for displaying to the user of a client computer for customization by the

user,

means for providing a tool allowing the user to supply at least text to be

printed on the first side,

means for providing an image of at least a portion of a second side of the

product for displaying to the user for customization by the user, the second side of

the product having a map area where a map will be printed when the product is

printed,

means for providing a tool allowing the user to identify a location to be

included within the map that will be printed in the map area,

means for making electronic map information available to a server

computer system, the map information containing information covering a relatively

large geographical area and being adapted to produce relatively high resolution

maps,

means, responsive to information received from the client computer system

identifying a location within the relatively large geographical area, for obtaining a

relatively high resolution user map from the map information, the user map

covering a relatively small geographical area that includes at least the identified

location,

means for generating a lower resolution display map version of the user

map, the display map being suitable for displaying at the client,

means for transmitting the display map to the client for displaying to the

user,

means for receiving a description of the product design from the client, the

description identifying at least a portion of the display map, and

means for associating the identified portion of the display map with the

corresponding higher resolution map information such that the product design will

be printed using the higher resolution map information.

20. The system of claim 19 further comprising means for storing the obtained user

map at the server.

29. The system of claim 19 wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the map area.

30. A computer-implemented system for use in creating an electronic design of a product intended for subsequent printing, the system comprising

means for displaying an image of at least a portion of one side of the product to the user of a client computer, the side of the product having a map area where a map will be printed when the product is printed,

means for displaying a tool allowing the user to identify a location to be included within the map that will be printed in the map area,

means for supplying information to a server computer system having access to map information covering a relatively large geographical area and adapted to produce relatively high resolution maps, the supplied information identifying at least a location within the relatively large geographical area,

means for receiving a display map from the server, the display map covering a relatively small geographical area that includes at least the identified location and being at a relatively low resolution suitable for displaying at the user computer,

means for displaying at least a portion of the display map such that the displayed portion of the display map is displayed to the user in the map area, and

means for transmitting a description of the electronic product design to the server for subsequent printing of the product, the description identifying the

incorporated portion of the display map such that the server can associate the
received product design with a corresponding higher resolution map at the server.

31. The system of claim 30 further comprising allowing the user to supply different
information to the server such that a different display map will be received.

32. The system of claim 31 wherein the different information is a different
location.

33. The system of claim 31 wherein the different information is a different zoom
level.

34. The system of claim 30 further comprising means for displaying the display
map with a user-controllable crop box such that the user can vary the portion of the
display map displayed in the map area.

35. The system of claim 30 further comprising

 means for requesting a display of one or more thumbnail map images
stored on the server,

 means for selecting one of the displayed thumbnail images, and

 means for receiving a display map associated with the selected thumbnail
images from the server.

36. The system of claim 35 further comprising means for replacing the at least a portion of the received display map currently displayed in the map area with at least a portion of the received display map associated with a selected thumbnail image.

IX.   Evidence Appendix

Table of Authorities

Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551, 13 USPQ2d 1301 (Fed. Cir. 1989), page 35

In re Costello, 717 F.2d 1346, 1349, 219 USPQ 389, 391 (Fed. Cir. 1983), page 22

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In re Payne, 606 F.2d 303, 314-315 (CCPA 1979), page 35

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In re Rouffett, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998), page 21

In re Yates, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (C.C.P.A. 1981), page 31

X.   Related Proceedings Appendix

None